

ESTTA Tracking number: **ESTTA321145**

Filing date: **12/09/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	New York Yankees Partnership
Granted to Date of previous extension	12/09/2009
Address	Executive Offices Yankee Stadium One East 161st Street Bronx, NY 10451 UNITED STATES
Attorney information	Elise Kasell Cowan Liebowitz & Latman 1133 Avenue of the Americas New York, NY 10036 UNITED STATES eck@cll.com, trademark@cll.com Phone:212-790-9200

Applicant Information

Application No	76692347	Publication date	08/11/2009
Opposition Filing Date	12/09/2009	Opposition Period Ends	12/09/2009
Applicants	Westenhaver, Barry Po Box 3744 Jackson, WY 83001 UNITED STATES Miller, Dean Po Box 3744 Jackson, WY 83001 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2008/06/15 First Use In Commerce: 2008/07/28

All goods and services in the class are opposed, namely: Clothing, namely, t-shirts and baseball caps

Grounds for Opposition

Other	See attached pleading.
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Attachments	Letter to Commissioner GRANDPA HATED PINSTripES NOO.pdf (1 page)(34755 bytes) GRANDPA HATED PINSTripES Notice of Opposition.pdf (7 pages)(32650 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Elise Kasell/
Name	Elise Kasell
Date	12/09/2009

Cowan, Liebowitz & Latman, P.C.

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December 9, 2009

By Electronic Filing

Commissioner for Trademarks
Attn: TTAB
P.O. Box 1451
Alexandria, VA 22313-1451

Re: New York Yankees Partnership
Notice of Opposition Against
Barry Westenhaver and Dean Miller
Application to register GRANDPA HATED PINSTRIPES
Ref. No. 21307.033

Dear Commissioner:

We enclose a Notice of Opposition against Application Serial Number 76/692,347 published in the Official Gazette on August 11, 2009. Contemporaneously with the electronic filing of this Notice of Opposition, we are arranging for an electronic payment in the amount of \$300 to cover the filing fee.

If the amount received is insufficient and additional fees are required, please charge our Deposit Account No. 03-3415.

Please address all future correspondence to the attention of Mary L. Kevlin of Cowan, Liebowitz & Latman, P.C.

Respectfully submitted,

/Elise Kasell/

Elise Kasell

Enclosures

cc: Ms. Diane Kovach (w/encs. – by fax)
Mary L. Kevlin, Esq. (w/encs.)
Richard S. Mandel, Esq. (w/encs.)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 76/692,347

Filed: August 25, 2008

For Mark: GRANDPA HATED PINSTripES and Design

Published in the Official Gazette: August 11, 2009

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NEW YORK YANKEES PARTNERSHIP,	:	
Opposer,	:	Opposition No.
	:	
v.	:	
	:	
BARRY WESTENHAVER AND DEAN MILLER,	:	<u>NOTICE OF OPPOSITION</u>
Applicants.	:	
-----X	:	

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer, New York Yankees Partnership (“Opposer” or “Club”), an Ohio limited partnership, with offices at Executive Offices, Yankee Stadium, One East 161st Street, Bronx, New York 10451, believes that it will be damaged by registration of the mark GRANDPA HATED PINSTRIPES and Design shown below:



(“Applicants’ Mark”) in International Class 25 for

“Clothing, namely, t-shirts and baseball caps” as shown in Application Serial No. 76/692,347

(the “Application”), and having been granted an extension of time to oppose up to and including December 9, 2009, hereby opposes the same.

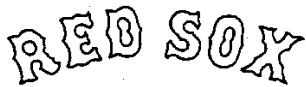
As grounds for opposition, it is alleged that:

1. Opposer is the owner of the renowned NEW YORK YANKEES MAJOR LEAGUE BASEBALL club.

2. On August 25, 2008, Applicants filed the Application in the United States Patent and Trademark Office (“USPTO”) for “Clothing, namely, t-shirts and baseball caps” in International Class 25, claiming an earliest first use date of June 15, 2008 and an earliest first use in commerce date of July 28, 2008.

3. Since long prior to June 15, 2008, Applicants’ earliest claimed first use date, Opposer, its predecessors, and their affiliated and related entities, licensees and/or sponsors have used pinstripe design elements as part of the Club’s home uniforms. Indeed, the Club’s home uniform featuring its characteristic pinstripes has been primarily the same since 1936 (apart from minor changes), longer than any current uniform design in the history of the Major League Baseball clubs. In fact, Opposer owns a United States federal registration for its pinstripe uniform design mark in International Class 41, namely, Registration No. 2,029,421, for “entertainment services in the nature of baseball games and exhibitions.” Given this longstanding, well known and consistent use of such an iconic feature of their uniforms since long prior to June 15, 2008, Opposer has been commonly and extensively referred to by the press, media, fans and the public by the designation “PINSTRIPES” in addition to its name, NEW YORK YANKEES, and the shortened form, YANKEES. This widespread public usage of the “pinstripes” nickname inures to the benefit of Opposer.

4. Also well known to the media, press, fans, and public is Opposer's longstanding rivalry with the Boston Red Sox Major League Baseball Club whose uniforms have featured the word RED SOX in the color red and the following distinctive stylization:

The image shows the words "RED SOX" in a stylized, outlined font. The letters are slanted and have a hand-drawn, irregular appearance, characteristic of the Boston Red Sox's branding.

for over 70 years (the "Red Sox Stylization"). Use of wording in the Red Sox Stylization is likely to suggest an association with the Red Sox Club while use of the term PINSTripES is likely to suggest an association with Opposer. Thus, coupled together, use of the term GRANDPA HATED PINSTripES in the Red Sox Stylization superimposed on a baseball design is likely to suggest to consumers that "Grandpa" was a Red Sox fan and hated Opposer, the New York Yankees Club.

5. Accordingly, Applicants' Mark, GRANDPA HATED PINSTripES and Design, which is depicted in the well known Boston Red Sox stylization and the Red Sox's primary color red, combined with a depiction of a baseball and the prominent word "PINSTripES," a designation that refers to and is widely understood to identify the Club, in this context, uniquely points to Opposer. Furthermore, during a November 16, 2009 telephone conversation between Opposer's outside counsel, Elise Kasell, Esq. and one of the Applicants, Mr. Dean Miller, Mr. Miller confirmed that the PINSTripES portion of Applicants' Mark was intended to refer to the Opposer. Thus, Opposer would be injured by the granting of a certificate of registration to Applicants because Applicants' Mark would (1) be likely to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicants' goods, which are identical and/or closely related to the goods and/or services offered by Opposer, have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or

associated in some way with Opposer; and (2) falsely suggest a connection between Applicants and Opposer.

6. At the time Applicants filed and executed the Application, Applicants claimed that Applicants' Mark had been used in commerce at least as early as July 28, 2008 in connection with hats and t-shirts and submitted a specimen purportedly showing use of Applicants' Mark in connection with t-shirts. At the time of filing and executing the Application, Applicants submitted a sworn statement that "all statements made of his/her own knowledge are true" in connection with the statements contained within the Application.

7. Upon information and belief, Applicants did not make a bona fide use in commerce of Applicants' Mark in connection with the goods covered in the Application as of their claimed first use in commerce date of July 28, 2008, nor did Applicants make a bona fide use in commerce of Applicants' Mark as of the filing date of the Application. During the above-referenced November 16, 2009 telephone conversation between Opposer's outside counsel, Elise Kasell, Esq. and one of the Applicants, Mr. Miller, Mr. Miller mentioned that the Applicants had not yet manufactured any hats bearing the GRANDPA HATED PINSTripES mark and that although the Applicants had manufactured approximately 50 t-shirts bearing Applicants' Mark, Applicants had not yet sold any of these t-shirts. Rather, Mr. Miller mentioned that Applicants had, unsolicited, sent half a dozen of the 50 manufactured t-shirts bearing Applicants' Mark to a sports bar in California and had handed out some of the t-shirts to friends and acquaintances. Mr. Miller further stated that the California sports bar had responded that they were not interested in such t-shirts and that their bartenders would never wear them. Such use by the Applicants does not rise to the level of "use in commerce" pursuant to Section 45 of the Lanham Act, 15 U.S.C. §1127. Because Applicants have not made a bona fide use of Applicants' Mark

in commerce as of the filing in the USPTO of the Application for either of the goods covered by the Application, Applicants have failed to satisfy the “use in commerce” requirement of Section 45 of the Lanham Act, 15 U.S.C. §1127, and their application is void on that ground.

8. Upon information and belief, at the time they filed and executed the Application and the sworn declaration, Applicants knew that they had not used the Applicants’ Mark in commerce for goods covered in the Application, contrary to Applicants’ sworn statements that “all statements made of his/her own knowledge are true.”

9. Upon information and belief, Applicants made this false material misrepresentation with the specific intent to deceive or mislead the USPTO and in order to procure registration of Applicants’ Mark when Applicants knew they were not entitled to such registration as evidenced by Mr. Miller’s statements that Applicants had not manufactured any hats bearing Applicants’ Mark and that although Applicants had manufactured approximately 50 t-shirts, Applicants had not sold any of the manufactured t-shirts and that the unsolicited t-shirts sent to a sports bar were not being used or displayed.

10. Accordingly, upon information and belief, Applicants had not, in fact, made use of Applicants’ Mark in commerce as of the filing date of their Application and, thus, committed fraud on the USPTO in the filing of their Application.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicants’ Mark and requests that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Mary L. Kevlin, Richard S. Mandel and Elise C. Kasell (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Mary L. Kevlin, Esq. at the address listed below.

Dated: New York, New York
December 9, 2009

COWAN LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Elise Kasell/

Mary L. Kevlin
Richard S. Mandel
Elise Kasell
1133 Avenue of the Americas
New York, New York 10036
(212)790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on December 9, 2009, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant and Correspondent of Record, Barry Westenhaver, Orso LTD, PO Box 3744, Jackson, Wyoming 83001-3744.

/Elise Kasell/
Elise Kasell